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EXAMINER

PORTER, RACHEL L

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/042,236	<b>Applicant(s)</b> HALOW ET AL.	
	<b>Examiner</b> RACHEL L. PORTER	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-27 (misnumbered (22-25)) is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-27 (misnumbered (22-25)) is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communication is in response to the request to reopen prosecution and amendment filed 9/22/09. Claims 1-23 have been cancelled. Claims 24-27 (misnumbered as claims 22-25) are pending.

### ***Claim Objections***

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 22-25 have been renumbered 24-27 respectively.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 24-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly filed claims introduce the term "electro-mechanical device." Exemplary claim 24 recites an "electro-mechanical device for inputting treatment information...and transforming said medical treatment into electrical signals...". Exemplary claim 26 (formerly 24) recites inputting medical information into an "electro-mechanical device."

It is noted that applicant further recites that the recited system includes a computer, and that applicant has also used means+ function language to describe system components. However, the Applicant's specification provides no antecedent basis for the term "electromechanical device." Therefore, it is considered to be new matter.

Claims 25 and 27 inherit the deficiencies of there respective independent claims through dependency, and are therefore also rejected.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 24-27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24 and 26 recite include the following limitations " multiple medical treatments performed during a time period selected from a group including one or more of: multiple medical treatments performed at the same time by an individual practitioner; denial of other claims for medical treatment during the same time period; and prior

Art Unit: 3626

payment for medical treatments performed during the same time period by an individual practitioner; mutually exclusive medical treatment codes...”

As written, it is unclear which Markush grouping the phrase “mutually exclusive medical treatment codes...” falls into. In particular, it is not clear whether applicant intends for it to be one of the “*multiple medical treatments performed during a time period selected from a group including one or more of:*” or whether it is included in the grouping of “*under one or more of the following blocking conditions.*” For examination, the examiner will interpret mutually exclusive medical treatments as “*one or more of the following blocking conditions.*”

Claims 25 and 27 inherit the deficiencies of their respective independent claims through dependency, and are therefore also rejected.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holloway et al (US 5253164A) in view of Moore et al (US 5930759A) .

[claim 24] Holloway discloses an apparatus for making health care insurance provider reimbursable payments to practitioners for claims submitted to health care

Art Unit: 3626

insurance providers for a medical treatment provided to a patient, said apparatus comprising:

- an electro-mechanical device for inputting medical treatment information to include the time of the medical treatment, the identity of the practitioner performing the medical treatment, a diagnostic code and a treatment code and (col. 4, lines 25-40: *user designated at 3 enters various facts from the claims into the computer system*  
*2. Such facts include, in addition to the entries for the one or more medical procedures for which payment is sought, other data such as age of the patient, claim number, date(s) of treatment(s) and procedure(s), the name of the physician, etc.);* and transforming said medical treatment information into electrical signals;; ( col. 4, lines 25-40: *user designated at 3 enters various facts from the claims into the computer system*  
*2. Such facts include, in addition to the entries for the one or more medical procedures for which payment is sought, other data such as age of the patient, claim number, date(s) of treatment(s) and procedure(s), the name of the physician, etc.)*)
- means for transmitting said electrical signals to a computer, said computer having access to memory for storing a data base including diagnostic codes, treatment codes and health care insurance provider treatment approvals; ( col. 4, lines 41-50--*user inputs information into computer(2); col. 4, lines 51-col. 5, line 7--The appropriate code(s) are then sent to the knowledge base interpreter 5 for its assessment of the coded claims. The interpreter 5, using the rules of the present*

Art Unit: 3626

*invention, interacts with the knowledge base 6 of the present invention and returns to the user 3)*

- said computer being programmed to block health care insurance provider reimbursable payments to practitioners for claims submitted to health care insurance providers for medical treatments under one or more of the following blocking conditions: (col. 3, lines 58-68):
  - absence of medical treatment approval for the patient by a health care insurance provider;
  - medical treatment code is inconsistent with a diagnostic code; (Appendix A, Example 1)
  - multiple medical treatments performed a time period selected from a group including one or more of: multiple medical treatments performed at the same time by an individual practitioner (col. 3, lines 50-57); denial of other claims during the same time period by an individual practitioner for medical treatment; and prior payment for medical treatments performed during the same time period by an individual practitioner;
  - mutually exclusive medical treatment codes;
- said computer being programmed to make health care insurance provider reimbursable payments to practitioners in response to claims for medical treatments provided and request reimbursement for the claims from the health care insurance providers. (col. 4, lines 41-50; 56-66)

Holloway discloses providing/inputting information regarding the patient (e.g. patient age--col. 5, line 22-30), but does not express inputting identity of the patient. Moore discloses a system and method in which a payment request includes patient identification information (col. 5, lines 41-50) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Holloway with the teaching of Moore to input patient identification information in the claim submission/payment request. One would have been motivated to include this information to provide additional parameters with which to check the validity of the charges.

[claim 25] Holloway discloses the apparatus as defined in Claim 24 further including means for transmitting information from information from said computer to an additional computer system, (col. 4, lines 64-68 *the user 3 then may authorize payment to the provider of the processed claim or may forward that information via input into computer system 4*), but does not expressly disclose transmitting information to a health care service provider.

Moore discloses a method/system wherein a user transmits claims processing information from a network computer (e.g. clearinghouse) to a health care insurance provider (Figure 1; col. 4, lines 43-57)

At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the claims processing method/system of Holloway with the ability to transmit information to a healthcare insurance provider from the user computer



Art Unit: 3626

feature disclosed by Moore. The claimed invention is merely a combination of old elements, and in the combination, the each element would merely have performed in the same function (transmitting and receiving information from a system computer) as it did separately. One of ordinary skill in the art would have recognized that the results of the combination were predictable.

[claim 26]      Holloway discloses a method for making health care provider reimbursable payments to practitioners for claims for medical treatments provided to patients, said method comprising the steps of:

- inputting medical treatment information including the time of the medical treatment, the identity of the practitioner performing the medical treatment, a diagnostic code and a treatment code into an electro-mechanical device; ( col. 4, lines 25-40: *user designated at 3 enters various facts from the claims into the computer system 2. Such facts include, in addition to the entries for the one or more medical procedures for which payment is sought, other data such as age of the patient, claim number, date(s) of treatment(s) and procedure(s), the name of the physician, etc.)*
- transforming said medical treatment information into electrical signals;( col. 4, lines 25-50--user inputs information into computer system)
- transmitting said electro-mechanical signals to a computer having access to a memory for storing a data base including diagnostic codes, treatment codes and health care insurance provider treatment approvals; ( col. 4, lines 41-50--user inputs information into computer(2); col. 4, lines 51-col. 5, line 7--*The appropriate code(s)*

Art Unit: 3626

*are then sent to the knowledge base interpreter 5 for its assessment of the coded claims. The interpreter 5, using the rules of the present invention, interacts with the knowledge base 6 of the present invention and returns to the user 3)*

- causing said computer to block health care insurance provider reimbursable payments to practitioners for claims submitted to health care insurance providers for medical treatments under one or more of the following conditions (col. 3, lines 58-68):
  - absence of medical treatment approval for the patient by a health care insurance provider;
  - medical treatment code is inconsistent with a diagnostic code; (Appendix A, Example 1)
  - multiple medical treatments performed during a time period selected from a group including one or more of: multiple medical treatments performed at the same time by an individual practitioner (col. 3, lines 50-57); denial of other claims for medical treatment during the same time period; and prior payment for medical treatments performed during the same time period by an individual practitioner;
  - mutually exclusive medical treatment codes;
- causing said computer to make health care insurance provider reimbursable payments to practitioners in response to claims for medical treatments provided and request reimbursement for the claims from the health care insurance providers. (col. 4, lines 41-50; 56-66—)

Holloway discloses providing/inputting information regarding the patient (e.g. patient age--col. 5, line 22-30), but does not express inputting identity of the patient. Moore discloses a system and method in which a payment request includes patient identification information (col. 5, lines 41-50) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Holloway with the teaching of Moore to input patient identification information in the claim submission/payment request. One would have been motivated to include this information to provide additional parameters with which to check the validity of the charges.

[claim 27] Holloway discloses the method as defined in Claim 26 further including the step of transmitting information from said computer to an additional computer system, (col. 4, lines 64-68 *the user 3 then may authorize payment to the provider of the processed claim or may forward that information via input into computer system 4*), but does not expressly disclose transmitting information to a health care service provider.

Moore discloses a method/system wherein a user transmits claims processing information from a network computer (e.g. clearinghouse) to a health care insurance provider (Figure 1; col. 4, lines 43-57)

At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the claims processing method/system of Holloway with the ability to transmit information to a healthcare insurance provider from the user computer feature disclosed by Moore. The claimed invention is merely a combination of old

Art Unit: 3626

elements, and in the combination, the each element would merely have performed in the same function (transmitting and receiving information from a system computer) as it did separately. One of ordinary skill in the art would have recognized that the results of the combination were predictable.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 24-27 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3626

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL L. PORTER whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 10-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./  
Examiner, Art Unit 3626

/Robert Morgan/  
Primary Examiner, Art Unit 3626